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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,335	07/05/2001	Peter Bernhard Kaars	US018099	5618

7590

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EXAMINER

CHEA, PHILIP J

ART UNIT

PAPER NUMBER

2153

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/900,335

Applicant(s)

KAARS, PETER BERNHARD

Examiner

Philip J. Chea

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This Action is in response to an Amendment filed February 18, 2005. Claims 1-8 are currently pending. Any rejection not set forth below has been overcome by the current Amendment.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites verifying if the content information is stored in a non-shared disk location between the sender and the receiver. The closest written description is located on page 3 paragraph [009] and page 4 paragraphs [013] and [014]. Paragraph [009] shows that the server checks if content information is available from another source on the Web. It cannot be determined if this other source is non-shared. Paragraphs [013] and [014] show software determining if the content information can be located publicly on the Web. Again, it is unsure if this publicly available content is contained on a non-shared disk.

Claims 2-6 are rejected by virtue of being depended on a rejected claim.

#### ***Claim Rejections - 35 USC § 103***

3. Claims 1,2,7,8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ramaley et al. (U.S. 6,687,741), and further in view of Beck et al. (US 5,903,723).

As per claims 1, 7, and 8, Ramaley et al. disclose a system of controlling communication of content information from a sender to a receiver via a data network, as claimed, comprising verifying if:

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- the content information is available from a source other than the sender (column 5, lines 51-64); and
- if the content information is stored in a disk location between the sender and receiver (column 5, lines 51-64)
- if the content information is available from the other source, substituting for the content information a pointer to the other source (column 5, lines 51-64).

Although the system disclosed by Ramaley et al. shows substantial features of the claimed invention (discussed above), it fails to disclose that the disk is non-shared.

Nonetheless, these features are well known in the art and would have been an obvious modification of the system disclosed by Ramaley et al., as evidenced by Beck et al.

In an analogous art, Beck et al. disclose a system for transmitting email attachments from a sender of a network to a recipient of a network where an attachment is stored in a storage device; further showing that storage device being a non-shared disk location between the send and the receiver (see columns 5 and 6, lines 63-67 and 1-7, where the non-shared disk is considered the WWW HTTP server).

Given the teaching of Beck et al., a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ramaley et al. by employing a storage location for attachments located on a non-shared disk location, such as disclosed by Beck et al., in order to allow a user to access the contents of their email message by means of a pointer, whether the contents are stored publicly or locally.

As per claim 2, Ramaley et al. in view of Beck et al. further disclose controlling communication content on request of at least the sender (see Ramaley et al. column 6, lines 4-19).

4. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ramaley et al. in view of Beck et al. as applied to claim 1 above, and further in view of Berghel. Although Ramaley et al. in view of Beck et al. disclose substantial features of the claimed invention (discussed above), he fails to directly disclose verifying the content based on a watermark. However, these features are well known in the art

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and would have been an obvious modification of the system disclosed by Ramaley et al. in view of Beck et al., as evidenced by Berghel.

In an analogous art, Berghel discloses watermarks being used as a method of authenticating a document for verification purposes (page 2, see WATERMARKS IN USE, line 1), such as claimed above.

Given the teaching of Berghel, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ramaley et al. in view of Beck et al. by employing a verification method based on watermarks, such as disclosed by Berghel, in order to guarantee authenticity, quality, ownership, and source (page 1, see Watermarking Cyberspace, 3<sup>rd</sup> paragraph). It would have been obvious to use the fingerprinting system taught by Zabetian to verify that a particular document located at another source is the same document from the local source.

5. Claims 4-6 rejected under 35 U.S.C. 103(a) as being unpatentable over Ramaley et al. in view of Beck et al. as applied to claim 1 above, and further in view of Zabetian (U.S. 6,327,656).

As per claim 4, although Ramaley et al. in view of Beck et al. disclose substantial features of the claimed invention (discussed above), he fails to directly disclose verifying the content based on a fingerprint of the content. However, these features are well known in the art and would have been an obvious modification of the system disclosed by Ramaley et al. in view of Beck et al., as evidenced by Zabetian.

In an analogous art, Zabetian discloses a system that can receive and transmit electronic mail (column 2, lines 42-45), verifying the document is the one to be received by using a fingerprint (column 7, lines 21-29).

Given the teaching of Zabetian, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ramaley et al. in view of Beck et al. by employing a fingerprinting method, such as disclosed by Zabetian, in order to identify and distinguish the document from other documents, even one that appear to be similar from one another (column 2, lines 4-9). It would have been obvious to use the fingerprinting system taught by Zabetian to verify that a particular document located at another source is the same document from the local source.

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As per claim 5, although Ramaley et al. in view of Beck et al. disclose substantial features of the claimed invention (discussed above), he fails to directly disclose the communication being carried out depending on the sender being authorized to communicate the content information. However, these features are well known in the art and would have been an obvious modification of the system disclosed by Ramaley et al. in view of Beck et al., as evidenced by Zabetian.

In an analogous art, Zabetian discloses a system that can receive and transmit electronic mail conditionally being carried out depending on the sender being authorized to communicate the content (column 6, lines 37-53).

Given the teaching of Zabetian, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ramaley et al. in view of Beck et al. by employing a sender authorization, such as disclosed by Zabetian, in order to certify the content that is being transmitted, and be alerted of any fraudulent activity (column 6, lines 54-62).

As per claim 6, although Ramaley et al. in view of Beck et al. disclose substantial features of the claimed invention (discussed above), he fails to directly disclose the communication being carried out depending on the receiver being authorized to receive the content. However, these features are well known in the art and would have been an obvious modification of the system disclosed by Ramaley et al. in view of Beck et al., as evidenced by Zabetian.

In an analogous art, Zabetian discloses a system that can receive and transmit electronic mail depending on the receiver being authorized to receive the content information (column 11, lines 17-43).

Given the teaching of Zabetian, a person having ordinary skill in the art would have readily recognized the desirability and advantages of modifying Ramaley et al. in view of Beck et al. by employing a receiver authorization, such as disclosed by Zabetian, in order to confirm the receiver was correctly intended (column 11, lines 53-62).

### ***Response to Arguments***

6. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

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**Conclusion**

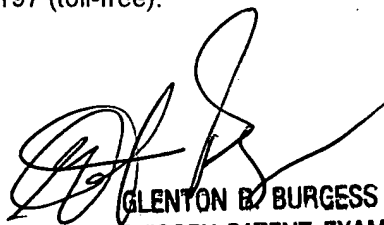
7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip J. Chea whose telephone number is 571-272-3951. The examiner can normally be reached on M-F 7:00-4:30 (1st Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Burgess can be reached on 571-272-3949. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
GLENTON B. BURGESS  
SUPERVISORY PATENT EXAMINER  
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Philip J Chea  
Examiner  
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PJC 4/27/05